

### **Remarks**

Reconsideration of the present application is respectfully requested. Claims 1 and 12 have been amended. Claims 13-23 have been canceled. New claims 24-31 have been added. Claims 1-12 and 24-31 are now pending.

Claims 2-7, 9, 11-18, 20 and 22-23 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1-2, 6, 8, 13, 17 and 19 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,768,528 to Stumm ("Stumm"). Claims 3, 5, 10-11, 14, 16 and 21-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stumm in view of U.S. Patent No. 6,182,117 to Christie et al. ("Christie"). Claims 4, 9, 15 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stumm in view of Christie and further in view of U.S. Patent No. 5,913,041 to Ramanathan et al. ("Ramanathan"). Finally, claims 7, 12, 18 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stumm in view of Ramanathan.

### **Rejection based on 35 U.S.C. § 112**

As mentioned above, claims 2-7, 9, 11-18, 20 and 22-23 stand rejected under 35 U.S.C. § 112, first paragraph. Given that claims 13-23 have been canceled, this rejection is now moot with respect to claims 13-18, 20 and 22-23. Applicants respectfully traverse this rejection with respect to pending claims 2-7, 9 and 11-12.

It is well-established that originally filed claims constitute their own written disclosure. *See e.g., In re Kollar*, 613 F.2d 819, 204 USPQ 702, 706 (CCPA 1980); *In re Wertheim*, 541 F.2d 257, 191 USPQ 90, 98 (CCPA 1976). However, at pages 2-5, the Office Action quotes certain passages from claims 2-4, 7, 9 and 11 and, in each instance, the Office

Action states that there “is no disclosure in the specification of” the subject matter in question. Moreover, the Office Action rejects claim 5 on the same basis as claim 3 and rejects claims 6 and 12 on the same basis as claim 2. Thus, the Office Action fails to acknowledge that these originally filed claims constitute a disclosure of the claimed subject matter. Applicants respectfully submit that the subject matter of claims 2-7, 9 and 11-12 is in fact disclosed in the specification and that such disclosure would enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without undue experimentation. Accordingly, Applicants respectfully request withdrawal of the rejection under § 112.

With respect to claim 11, the passage quoted at pages 4-5 of the Office Action does not appear in the claim. For at least this additional reason, Applicants request withdrawal of the rejection under § 112 as to claim 11.

**Rejection based on 35 U.S.C. § 102**

Claims 1-2, 6, 8, 13, 17 and 19 are rejected under 35 U.S.C. § 102(b) as anticipated by Stumm. Given that claims 13-23 have been canceled, this rejection is now moot with respect to claims 13, 17 and 19. Applicants have amended independent claim 1 to correct minor informalities and to clarify that the intended scope of the claim involves sending the electronic document directly from the sending device to the receiving device.

Independent claim 1, as amended, is directed to an apparatus for delivering an electronic document comprising a sending device, which functions to send an electronic document; at least one receiving device, which functions to receive the electronic document directly from the sending device; and a network between the sending device and the receiving device, wherein the network functions to allow the sending device to send a notification to the receiving device, and wherein the receiving device sends a notification to the sending device

whereby the sending device forwards the electronic document directly to the receiving device. By contrast, Stumm discloses a server system which is as an intermediary between a plurality of publishers and a plurality of subscribers.

Stumm does not anticipate independent claim 1 because it fails to disclose each and every limitation of the claim. In particular, Stumm fails to disclose that “the sending device forwards the electronic document directly to the receiving device.” According to the Office Action, Stumm discloses a sending device (server 20) and at least one receiving device (subscribers 26). *See* Office Action at page 6. Applicants respectfully point out that in Stumm the “sending devices” are actually the publishers 24 rather than the server 20. The publishers 24 each transmit “the data files that it intends to target to the subscribers to server system 20 for storage in database 16.” Stumm at col. 4, lines 19-23. Then, at predetermined intervals, each subscriber computer 26 is connected to the server system 20 and downloads the intended information. Stumm, col. 4, lines 23-26. Because Stumm fails to disclose forwarding an electronic document directly from a publisher to a subscriber, Stumm does not anticipate amended claim 1.

Stumm also fails to disclose the exchange of notifications between the sending device and the receiving device recited in independent claim 1. As noted at page 6 of the Office Action, Stumm discloses certain communications between the server 20 and the subscriber 26 (e.g., sending a schedule of events file from server 20 to the subscribers). However, as mentioned above, server 20 is an *intermediary*, not a sending device. Stumm fails to disclose an exchange of notifications between a publisher 24 and a subscriber 26, and thus Stumm does not anticipate amended claim 1 for this additional reason.

Moreover, amended claim 1 is patentable over Stumm. Not only does Stumm fail to disclose each and every limitation of claim 1, but Stumm actually teaches away from the claimed subject matter by teaching the use of an intermediary. As set forth at page 11 of Applicants' specification, "other prior art patents . . . largely entail storage or buffer means which act as an intermediary between the sender and the recipient. In addition, it should be noted that although several prior art patents teach the usage of scheduling devices, no patent provides the same in the context of direct file or document delivery. . . ." In contrast to the teaching in Stumm to employ an intermediary, amended claim 1 is directed to an apparatus for direct delivery of an electronic document from a sending device to at least one receiving device. Accordingly, Applicants respectfully submit that amended claim 1 patentably distinguishes over Stumm and request allowance of the claim.

Claims 2, 6 and 8 depend from independent claim 1 and are thus patentable over Stumm for at least the reasons stated above with respect to claim 1. Moreover, claims 2, 6 and 8 are separately patentable because they contain additional limitations that are neither taught nor suggested by Stumm. For example, claims 2 and 6 each include the further limitation that the sending device and the receiving device automatically record all notifications sent to and received from one another. Stumm does not disclose this additional limitation. Accordingly, Applicants respectfully submit that dependent claims 2, 6 and 8 are also patentable over Stumm.

For the reasons stated above, Applicants submit that claims 1-2, 6 and 8 are not anticipated by Stumm and thus request withdrawal of the rejection under § 102. Furthermore, Applicants submit that claims 1-2, 6 and 8 are patentable over Stumm and that these claims are in condition for allowance.

**Rejections based on 35 U.S.C. § 103**

Claims 3, 5, 10-11, 14, 16 and 21-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stumm in view of Christie. Claims 4, 9, 15 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stumm in view of Christie and further in view of Ramanathan. Finally, claims 7, 12, 18 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stumm in view of Ramanathan. Given that claims 13-23 have been canceled, this rejection is now moot with respect to claims 14-16, 18 and 20-23. Applicants respectfully traverse this rejection with respect to pending claims 3-5, 7 and 9-12.

The Office Action contends that various combinations of Stumm, Christie and/or Ramanathan render claims 3-5, 7 and 9-12 obvious. Stumm, which is the primary reference for each of the obviousness rejections, has been discussed above in detail with respect to claim 1. Christie discloses a method and apparatus for workgroup information replication. As set forth at page 4 of Applicants' specification, Ramanathan teaches a method and system of monitoring throughput of a data access system which includes logging each transfer of data from a content server to a remote site, with each log entry including information indicative of transfer size, data, times, source and destination.

Claims 3-5, 7 and 9-11 depend either directly or indirectly from base claim 1. As mentioned above, claim 1 is patentable over Stumm, and dependent claims 3-5, 7 and 9-11 are therefore patentable over Stumm for at least the reasons stated above with respect to claim 1. Claim 1 is also patentable over Christie and Ramanathan, taken either individually or in any permissible combination with Stumm for at least the reason that none of these references teach an exchange of notifications between a sending device and a receiving device in combination with a sending device that forwards the electronic document directly to the receiving device as recited in the claim. Accordingly, dependent claims 3-5, 7 and 9-11 are necessarily patentable

over Stumm, Christie and Ramanathan, taken alone or in any permissible combination, for at least the reasons supporting the patentability of claim 1 over these references.

To the extent dependent claims 3-5, 7 and 9-11 contain additional limitations beyond base claim 1 that are neither taught nor suggested by the cited references, these claims are separately patentable. For example, the Office Action contends that many of the additional limitations of dependent claims 3, 5, 7 and 9 are taught by Stumm. *See* Office Action at pages 8-9 and 12-14. However, as explained above with respect to claim 1, the Office Action mischaracterizes Stumm's server 20 as a sending device when in fact it is an intermediary. Thus, the proposed combination of Stumm with Christie and/or Ramanathan fails to teach or suggest the additional limitations of the dependent claims, including at least dependent claims 3, 5, 7 and 9.

Turning next to independent claim 12, the claim stands rejected as obvious over the proposed combination of Stumm with Ramanathan as described at pages 15-16 of the Office Action. Applicants have amended claim 12 to correct minor informalities and to clarify that the sending device sends the electronic document directly to the receiving device. Claim 12, as amended, is directed to an apparatus for automatic management and allocation of network traffic based on requests to use network capacity, wherein the apparatus comprises a sending device, which functions to send an electronic document; a bandwidth database which functions to store reservations for sending the electronic document; a channel manager, which comprises a plurality of algorithms which function to calculate a time to send the electronic document; at least one receiving device, which functions to receive the electronic document directly from the sending device; and a network between said sending device and receiving device, wherein transactions to send document transfers are managed through the channel manager and the

bandwidth database, wherein said sending device automatically records all notifications sent to and received from said receiving device, and whereby said receiving device automatically records all notifications sent to and received from said sending device.

The Office Action acknowledges at pages 15-16 that Stumm does not disclose “a channel manager, which comprises a plurality of algorithms which function to calculate a time to send the electronic document” as recited in claim 12. Furthermore, the Office Action notes that Stumm fails to disclose the recitation of claim 12 that “transactions to send document transfers” are managed through the channel manager and bandwidth database. Moreover, as discussed above with respect to claim 1, Stumm fails to disclose a sending device that forwards the electronic document directly to a receiving device and fails to disclose an exchange of notifications between a sending device and a receiving device. Given that Stumm actually teaches away from the claimed invention by teaching the use of an intermediary, there is no teaching or suggestion from the prior art to combine the teachings of Stumm with the teachings of Ramanathan to achieve the invention of claim 12. Even if it were permissible to combine Stumm and Ramanathan, there is no teaching or suggestion from the prior art to modify the proposed combination to achieve the claimed invention. Accordingly, Applicants respectfully submit that amended claim 12 is patentable over the proposed combination of Stumm and Ramanathan.

For the reasons stated above, Applicants submit that claims 3-5, 7 and 9-12 are patentable over Stumm, Christie and Ramanathan, whether taken individually or in any permissible combination, and thus request withdrawal of the rejection of these claims under § 103. Furthermore, Applicants submit that claims 3-5, 7 and 9-12 are in condition for allowance.

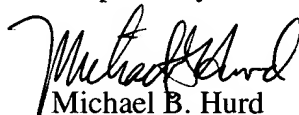
### New Claims 24-31

New claims 24-31 have been added. Applicants respectfully submit that new claims 24-31 also patentably define over the prior art of record and are thus in condition for allowance.

### Conclusion

For the reasons stated above, claims 1-12 and 24-31 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1-12 and 24-31. If any issues remain which would prevent issuance of this application, the Examiner is urged to contact the undersigned prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional fees that are required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,

  
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Attorney Docket No. QUCA.95091